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**MF**

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/858,245 05/19/97 PADOVANI

R QCFA418

023696  
Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
San Diego CA 92121-1714

WM01/0910

 EXAMINER

VO, N

ART UNIT	PAPER NUMBER
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2682

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DATE MAILED: 09/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/858,245	PADOVANI, ROBERTO
	Examiner Nguyen T Vo	Art Unit 2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 24 August 2001.
- 2a)  This action is FINAL.                                    2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 4-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5)  Claim(s) \_\_\_\_\_ is/are allowed.
  - 6)  Claim(s) 4-23 is/are rejected.
  - 7)  Claim(s) \_\_\_\_\_ is/are objected to.
  - 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Continued Application***

1. The request filed on 08-24-2001 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 08/858,245 is acceptable and a RCE has been established. An action on the RCE as follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4-9, 11-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to independent claims 4, 11, 16-17 and 22, the original specification fails to disclose the limitations "**regardless of the measurement value**" as recited in claims 4, 11, 17 and "**regardless of the strength of pilot**" as recited in claims 16, 22. Applicant's attention is directed to the original specification, page 9 line 29 to page 10 line 6, wherein pilot strength is measured and transmitted to the base station only if the pilot strength satisfies three conditions, *not regardless of the measurement value as*

*recited in the claims.* Therefore, it is clear that the measurement values are collected and saved only if they satisfy three conditions.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Andersson (5,375,123).

As to claim 10, Andersson discloses all the claimed limitations. More specifically, "a set of parameters" as claimed read on the set of transmission power to be used by a plurality of base stations (see column 4 lines 47-48); "operating the cellular network in a predetermined interval" as claimed reads on the time interval in which a mobile station measures pilot signals, and reports the measured pilot signals to the base stations (see column 4 lines 14-49); "collecting and saving data from received pilot strength measurement messages" as claimed reads on receiving the measurement values at the base stations (see column 4 lines 14-49); and "revising said set of parameters in accordance with said data from received pilot strength measurement messages" as claimed reads on modifying the transmission power at the base stations (see column 4 lines 42-49). Regarding the limitation that data are saved "to a database", applicant's attention is directed to Andersson, column 5 lines 25-35. Regarding the newly-added

claimed limitation of "optimize said cellular network", the word "optimize" is defined by Webster's Dictionary as "to make the most effective use of". In Andersson, the mobile stations are made to assist the system in handoff procedure (see Mobile-Assisted Handoff at column 4 lines 14-32). Therefore, Andersson reads on the newly-added claimed limitation of "optimize said cellular network".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blakeney, II (5,267,261; hereinafter simply referred to as Blakeney) in view of Sawyer (5,915,221).

As to claim 10, Blakeney discloses all the claimed limitations. More specifically, "a set of parameters" as claimed read on the Active Set, Candidate Set and Neighbor Set at column 21 lines 48-68; "operating the cellular network in a predetermined interval" as claimed reads on the time interval in which a mobile station measures pilot signals, and reports the measured pilot signals in Blakeney; "collecting and saving data from received pilot strength measurement messages" as claimed reads on column 19 lines 13-22, column 20 lines 3-17, column 22 lines 46-56, column 23 line 19 to column 28; and "revising said set of parameters in accordance with said data from received pilot strength measurement messages" as claimed reads on modifying the above Active Set,

Candidate Set and Neighbor Set as disclosed at column 19 lines 13-22, column 20 lines 3-17, column 22 lines 46-56, column 23 line 19 to column 28 in Blakeney. Regarding the newly-added claimed limitation of "optimize said cellular network", the word "optimize" is defined by Webster's Dictionary as "to make the most effective use of". In Blakeney, the mobile stations are made to assist the system in handoff procedure (see column 20 lines 1-17). Therefore, Blakeney reads on the newly-added claimed limitation of "optimize said cellular network".

Blakeney does disclose that the measurement data are transmitted to the MSC (see column 26 lines 56-66), but fails to expressly disclose that the measurement data are also stored at the MSC as recited in the claim. Sawyer discloses that measurement data transmitted from a mobile station are received and stored at the MSC (see column 11 lines 10-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Sawyer to Blakeney, in order to provide better measurement results which better indicate the channel quality (by averaging the measurement data as suggested by Sawyer at column 11 lines 31-35).

#### ***Response to Arguments***

8. Applicant's arguments filed 07-31-2001 have been fully considered but they are not persuasive.

Regarding the newly-added limitation in claim 10, applicants' attention is directed to the rejection above for the reasons as to how it is still rejected over the cited prior art.

Regarding the rejection to claims under 35 USC 112, first paragraph, applicants argue that the rejection is improper because the three conditions apply only to the transmission of the pilot strength measurement message and does not apply to the saving of pilot strength measurements. The examiner, however, disagrees. Since only pilot strength measurements which satisfy three condition are transmitted to the base station and saved in the database, these three condition also apply to the saving of pilot strength measurements. More specifically, according to page 9 lines 29-32 of the specification, the Pilot Strength Measurement Message transmitted from the mobile station 2 to the base station to be saved in PSMM database 21 includes all pilot with **energy greater than Tadd** and all members of the current active set who's measured pilot energy **has not fallen below Tdrop** for more than a predetermined time period. Therefore, all pilot with energy **less** than Tadd and all members of the current active set who's measured pilot energy **has fallen below Tdrop** for more than a predetermined time period **will not be saved**. Therefore, it is clear that page 9 lines 29-32 of the specification that applicant relies on does not disclose the limitations "regardless of the measurement value" as recited in claims 4, 11, 17 and "regardless of the strength of pilot" as recited in claims 16, 22.

For the foregoing reasons, the examiner contends that the rejection to claims is proper.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T Vo whose telephone number is (703) 308-6728. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chang can be reached on (703)308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nguyen Vo

September 8, 2001

  
NGUYEN T. VO  
PRIMARY EXAMINER